

## STATEMENT OF CLAIMS STATUS

Claims 1-13 are pending in the application.

Claims 11-13 are withdrawn from consideration by the Examiner.

Claims 1-10 stand rejected.

## SUMMARY OF OFFICE ACTION

### Election/Restriction

The Examiner states: Claims 1-10 are drawn to a method of exterminating insects, as classified in class 43 subclass 124, and that claims 11-13 are drawn to an aqueous solution containing capsicum, as classified in class 424; the inventions of claims 1-10 and 11-13, respectively, are distinct, each from the other; the claims 1-10 are distinct from claims 11-13 as shown by their different classification and by the search required; and therefore restriction for examination purposes as indicated is proper.

Examiner identifies a telephone conversation with Mr. Shahani, counsel for Applicant, held on 2-26-98 during which a provisional election was made with traverse to prosecute the invention of claims 1-10, as grouped by the Examiner in group I. Examiner requests written affirmation of this election.

### Claims Rejections - 35 USC § 101

Examiner states that claims 1-10 are rejected under 35 USC § 101 because the claimed invention is not supported by either a credible asserted utility or a well established utility. Examiner cites Hainrihar, 5,525,597, as support for the assertion that "prior art has established that the use of capsaicinoids, which encompasses capsicum, is nontoxic to insects" and basis for rejection of the claims on grounds that "applicant's claim that their invention of exterminating/killing insects with an aqueous solution containing capsicum is not credible unless the applicant can supply some form of evidence which disputes the assertion set out in the cited prior art.

RECEIVED  
TECHNOLOGY CENTER 3000  
58 AUG 19 08:37

## Claims Rejection - 35 USC § 112

Examiner also rejects claims 1-10 under 35 USC § 112, first paragraph, since the claimed invention is not supported by either a credible asserted utility or a well established utility for the reasons set forth in the rejections of claims 1-10 under 35 USC § 101.

## AMENDMENTS

### Specification

1. Please replace the title with the following:

Title (once amended) **CAPSICUM BASED [PESTICIDE] INSECTICIDE AND  
METHOD OF USE**

5

## RESPONSE

### Election/Restriction

Applicant hereby affirms the election of claims 1-10, with traverse, made by counsel during the telephone conversation with the Examiner.

10

### Claims Rejections

Applicant hereby respectfully requests that Hainrihar be withdrawn as a contrary or contradictory teaching under 35 USC § 101. The selected teaching of Hainrihar is not dispositive of the credibility of the present invention for the reason that the use of capsicum and other capsaicinoids has long been known to have insecticidal and insect repellent properties.

15

Ingestion of chile peppers by humans and even other animals, primarily mammals, as a food spice is a obvious, essentially non-toxic use. However, the extraction of the highly active and irritating chemical compounds so prevalent in the fruits of the chile pepper families described in the present invention into

aqueous solutions, such as by mixtures and compositions of ground chile peppers and water, creates a highly toxic, noxious, irritation pepper spray for direct contact onto *structure destroying* insects of the infestation. Insects in contact with the solution are instantly killed due to the highly toxic, corrosive, chemical digestion of the natural cellular structures, and surfaces contacted by the solution will be long repulsive or repellent to future organisms or insects.

#### **Declaration of Robert Heinz Neumann**

Filed concurrently herewith and incorporated herein in its entirety, please find the Declaration of Robert Heinz Neumann in support of Applicant's request for withdrawal of the rejection based on the teaching of Hainrihar.

#### **Teaching of Hoag, 312,270 Distinguished**

Applicant hereby brings to Examiner's attention the teaching of Hoag, 312,270 issued Feb. 17, 1885, the best copy of which is attached to the First Supplemental Information Disclosure Statement which is filed concurrently herewith and incorporated herein.

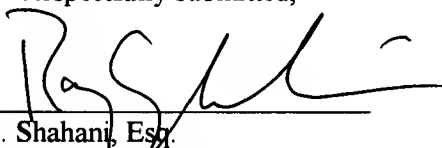
Hoag is distinguished and described in detail in Hainrihar, 5,525,597, column 1, lines 58-67. Furthermore, Hoag is not directed to, nor does he teach, an insecticide or method for exterminating infestations of structure infesting and destroying insects, such as termites, fungus, spiders, etc. consisting solely of an aqueous capsicum solution which is sprayed directly onto the insects or their infestations. Hoag is directed primarily to application of a solution containing additional chemicals other than capsicum onto the blooms of fruit trees, the developing fruit and onto the trees themselves (lines 25-34). The problem to which Hoag is directed is "an insecticide in preventing [...] destroying insects and their larvae from destroying fruit-trees and fruits" (lines 6-9). Applicant respectfully urges that this is not the same as extermination of termites, fungus which causes dry rot and other structure infesting and destroying pests in

structures such as houses, office buildings, etc., the problem to which the present invention is directed.

### CONCLUSION

Applicants submit that all claims, as presented and as amended herein, describe useful, novel and non-obvious patentable subject matter. Applicants further submit that all claims as presented and amended herein are presently allowable and respectfully request that Examiner allow the application to issue.

Respectfully submitted,

  
Ray K. Shahani, Esq.  
ATTORNEY AT LAW  
Registration No.: 37,554

Telephone: (650) 348-1444  
Facsimile: (650) 348-8655

### CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper and the documents referred to as attached therein are being deposited with the United States Postal Service using "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to "Commissioner of Patents and Trademarks, Washington, D.C. 20231" using express mail label number EH615005133US.

Signed:  Date Mailed: August 3, 1998